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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/625,289	07/23/2003	Abel G. Pereira	CRODA 3.0-013 CIP	7905
530	7590	04/12/2005	EXAMINER	
LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK 600 SOUTH AVENUE WEST WESTFIELD, NJ 07090			HARDEE, JOHN R	
			ART UNIT	PAPER NUMBER
			1751	

DATE MAILED: 04/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/625,289

Applicant(s)

PEREIRA ET AL.

Examiner

John R. Hardee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-22 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for compounds in which R8 and R11 are alkyl, does not reasonably provide enablement for R8 and R11 to be "anything", as argued in the response to the first office action. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make or use the invention commensurate in scope with these claims. The examiner recommends that the definitions of R8 and R11 be amended to reflect material for which applicant has clear basis in the specification. Applicant is cautioned to refrain from adding new matter.
3. Claims 17-22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is a new matter rejection. The examiner cannot find basis in the specification for the limitation that R8 and R11 are of 16 carbons or greater.

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4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-22 remain rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant has not provided satisfactory definitions for the R8 and R11 groups which are not of 17-35 carbons. Accordingly, the metes and bounds of the claims cannot be determined.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-22 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 60-81376 in view of applicant's admissions. The reference discloses fabric treating compositions comprising perfume and ingredients A-D, of which A may be an imidazolinium compound of the form shown at the bottom of p. 2, col. 1. R1 and R2 are alkyl or alkenyl of 10-24 carbons, R3 is alkyl or hydroxyalkyl of 1-3 carbons (p. 2, col. 2, lines 20+), and X can be any salt forming counterion, including halogen and methyl sulfate. Use of compositions with R groups derived from beef tallow is exemplified. While mixtures of compounds having the ratios of chain lengths recited by applicant are

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not disclosed, applicant's affidavit employs a composition in which the R groups come from beef tallow. Accordingly, the R group limitations appear to be met. Ingredients A+B are present at 10-95% of the compositions, more preferably 50-90% by weight, and B/(A+B) is 0.5%-40% of the composition as a whole. The compositions preferably comprise hydrocarbon waxes or higher alcohols, both of which are film formers, being insoluble in water. Additional surfactants are disclosed as being present, with an ethoxylated alkyl phenol, a nonionic surfactant, being present in Example 2. The compositions are formed by making a co-melt of ingredients A-D.

8. Claims 1-7 and 17-22 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by the *International Cosmetic Ingredient Dictionary and Handbook* in view of applicant's admissions. Note the definitions of Quaternium 27 and Quaternium 83. While mixtures of compounds having the ratios of chain lengths recited by applicant are not disclosed, applicant's affidavit employs a composition in which the R groups come from beef tallow. Accordingly, the R group limitations appear to be met.

9. Claims 1-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Nakama et al., US 4,919,846. See Example 40, cols. 19 and 20. The structure of the imidazoline surfactant is provided at the bottom of col. 16. The disclosure of an average MW implies that mixed R groups were used.

***Claim Rejections - 35 USC § 103***

10. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

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11. Claims 1-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 60-81376 in view of applicant's admissions. The reference discloses fabric treating compositions comprising perfume and ingredients A-D, of which A may be an imidazolinium compound of the form shown at the bottom of p. 2, col. 1. R1 and R2 are alkyl or alkenyl of 10-24 carbons, R3 is alkyl or hydroxyalkyl of 1-3 carbons (p. 2, col. 2, lines 20+), and X can be any salt forming counterion, including halogen and methyl sulfate. While mixtures of compounds having the ratios of chain lengths recited by applicant are not disclosed, use of compositions with R groups derived from beef tallow is exemplified, so the definition of the R groups clearly embraces mixtures of chain lengths. Applicant's affidavit employs a composition in which the R groups come from beef tallow. Accordingly, the R group limitations appear to be met. Furthermore, it is prima facie obvious to combine two compositions, each taught for the same purpose, to yield a third composition for that very purpose. *In re Kerkhoven*, 205 USPQ 1069, *In re Pinten*, 173 USPQ 801, and *In re Susi* 169 USPQ 423. When ingredients are well known and combined for their known properties, the combination is obvious absent unexpected results. *In re Crocket*, 126 USPQ 186 and *In re Pinten*, 173 USPQ 801. The person of ordinary skill in the surfactant art would expect combinations of these materials to behave in the same fashion as the individual materials, absent unexpected results. Ingredients A+B are present at 10-95% of the compositions, more preferably 50-90% by weight, and B/(A+B) is 0.5%-40% of the composition as a whole. Accordingly, the limitations of claims 61-63 can be met by following the teachings of the reference. The compositions preferably comprise hydrocarbon waxes or higher alcohols, both of

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which are film formers, being insoluble in water. Additional surfactants are disclosed as being present, with an ethoxylated alkyl phenol, a nonionic surfactant, being present in Example 2. The compositions are formed by making a co-melt of ingredients A-D. Addition of water is not disclosed. Claims drawn to personal care compositions recite intended use and are not afforded additional patentable weight. This reference differs from the claimed subject matter in that it does not disclose a composition which reads on applicant's claims with sufficient specificity to constitute anticipation.

It would have been obvious at the time the invention was made to make such a composition, because this reference teaches that all of the ingredients recited by applicants are suitable for inclusion in a surfactant composition. The person of ordinary skill in the surfactant art would expect the recited compositions to have properties similar to those compositions which are exemplified, absent a showing to the contrary. In the case where the claimed ranges overlap or lie inside ranges disclosed by the prior art, a *prima facie* case of obviousness exists. *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); *In re Woodruff*, 919 F.2d 1575, 16 USPQ2d 1934 (Fed Cir. 1990).

### ***Response to Arguments***

12. Applicant's arguments filed March 11, 2005 have been fully considered but they are not persuasive. Applicant's affidavit compares a hair treating composition of JP 58-144174 with one according to the invention. This is well taken, but this reference is not the closest prior art. Where the use of a beef tallow imidazolium surfactant is

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exemplified, as in JP 60-81376, that reference is the closest prior art, regardless of the intended use.

Upon reconsideration, applicant's claims appear to be anticipated by JP 60-81376, given that applicant admits that beef tallow meet the R group limitations. The examiner notes further that the beef tallow and hardened beef tallow imidazolium surfactants are well known commercial products--well enough known to have been assigned generic names in the *International Cosmetic Ingredient Dictionary and Handbook*. Their use in hair treatment compositions is disclosed. Applicant is assumed to be familiar with the commonly-available commercial products, and applicant is reminded of his duty of disclosure.

13. For the sake of brevity, the rejections over JP 58-144174 and Barnabas et al. are withdrawn.

14. This action contains new grounds of rejection not motivated by applicant's amendments. Accordingly, it is NOT FINAL.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to the examiner, Dr. John R. Hardee, whose telephone number is (571) 272-1318. The examiner can normally be reached on Monday through Friday from 8:00 until 4:30. In the event that the examiner is not available, his supervisor, Dr. Yogendra Gupta, may be reached at (571) 272-1316.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "J. Hardee", with a stylized, cursive script.

John R. Hardee

Primary Examiner

April 8, 2005